

REMARKS

A. Status of the Claims

Claim 1 was pending at the issuance of the present Office Action. Claim 3 is withdrawn as being drawn to non-elected subject matter. Claim 1 is rejected.

B. Claim Rejections – 35 USC §103

Claim 1 is rejected under 35 USC §103 as allegedly being unpatentable over Xiao in view of Clark *et al.*

MPEP §2143.03 requires that all claim limitations be considered in an obviousness determination, and the Board of Patent Appeal and Interferences (BPAI) recently confirmed that “obviousness requires a suggestion of all limitations in a claim.” *See In re Wada and Murphy*, Appeal 2007-3733, citing *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Circ. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). Applicants submit that none of the cited art teaches or suggests the use of the compounds in the present claims to treat primary open angle glaucoma. In particular, it is submitted that the teaching of Clark *et al.* fails to cure the conceded deficiency in Xiao, and that the asserted combination of Xiao and Clark *et al.* therefore fails to render the instant claims obvious.

The Action asserts that Clark *et al.* is cited in the aforementioned combination “to show what are the known ophthalmic neovascularization conditions in the art which include not only chronic glaucoma as asserted by Applicant, but also includes diabetic retinopathy and neovascular glaucoma” (Office Action, page 3). However, Clark mentions chronic glaucoma as a retinal disease to be treated by substituted hydrindanes. Clark separately mentions that substituted hydrindanes can be used to treat primary open angle glaucoma (col. 8, lines 42-46). Clark does not draw a connection between neovascular conditions and primary open angle glaucoma. Xiao does not relate at all to primary open angle glaucoma. Therefore, one of skill in the art would not have any reason to rely on Clark *et al.* for considering the treatment of primary open angle glaucoma with a compound of the instant

claims. Consequently, the asserted combination of references is deficient, and does not render the instant claims obvious.

In view of the foregoing discussion, Applicant submits that the combination of Xiao and Clark *et al.* does not render Claim 1 obvious. Consequently, Applicant respectfully requests that this ground of rejection be withdrawn.

C. Double Patenting

Claim 1 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/697,135. Applicants request that this rejection be held in abeyance until the pending claims are found to be otherwise allowable except for these grounds of rejection.

CONCLUSION

This is submitted to be a complete response to the outstanding Action. Based on the foregoing arguments, the claims are believed to be in condition for allowance; a notice of allowability is therefore respectfully requested.

The Examiner is invited to contact the undersigned attorney at (817) 615-5330 with any questions, comments or suggestions relating to the referenced patent application.

Respectfully submitted,

/Jason J. Derry, #50,692/

Jason J. Derry, Ph.D.
Reg. No. 50,692
Attorney for Applicants

Date: March 8, 2010